

### REMARKS

Claims 1-20 remain pending and at issue in the present application. Reconsideration and allowance of all pending claims are respectfully requested.

The Office rejects claims 1-20 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Applicant traverses this ground of rejection.

As an initial point, the Office has failed to apply the correct standard in concluding that the term "rigidly coupled" fails to comply with the written description requirement of 35 U.S.C. §112. In articulating the rejection, page 3 of the Office action states that:

The specification described the engagement on page 3 in lines 4-12 as being fixedly coupled, but there is no mention of a rigid or nonflexible connection. The only mention of rigid is in regards to the inner member.

The Office, therefore, argues that the absence of word-for-word support of the claimed term violates the written description requirement.

The M P E P., however, clearly states that the subject matter of a claim need not be described literally. M P E P. §2163.02. Instead, the proper standard for determining compliance with the written description requirement is whether the description conveys to one of ordinary skill, with reasonable clarity, that the applicant possessed the invention at the time the application was filed. Support for claimed subject matter may be found in the words and figures provided in the application. Furthermore, the Examiner has the burden of establishing a prima facie case by identifying the claim limitation at issue and providing reasons why a person of skill in the art would not have recognized that the inventor was in possession of the invention as claimed in view of the application as filed. In the present application, the Office failed to apply the proper standard for the written description requirement, and therefore the rejection based thereon must be withdrawn.

When the appropriate standard is applied, it is clear that the amended claims are fully and adequately described in the specification, and therefore comply with the written description requirement. Support for the "rigidly coupled" language is found throughout the specification and drawings as originally filed. First, page 6, lines 16-24, of the specification describe a rigid inner member 20 including a flange 78 defining a mounting surface 80. The

mounting surface is fixed to the seat 66 of the inner shaft 18. At page 9, lines 1-2, in describing operation of the catheter, the specification states, "The position of the catheter 100, and consequently the stent 108, is maintained due to its connection to the inner shaft 18 by way of the rigid inner member 20." Figs. 9-11 illustrate how the rigid inner member 20 and inner shaft 18 maintain the same positional relationship both before and after movement of the outer shaft 16. From this disclosure, one of skill in the art would understand that the coupling between the rigid inner member 20 and the inner shaft 18 must be rigid in order to maintain the positional relationship illustrated in the drawings. Accordingly, under the appropriate standard, the claims as presented are fully and adequately described in the specification as filed, and therefore the written description rejection must be withdrawn.

Turning to the rejections based on the prior art, the Office has rejected claims 1-19 under 35 U.S.C. §103(a) as allegedly obvious over U.S. Patent No. 5,634,928 ("Fischell") in view of U.S. Patent No. 5,026,377 ("Burton"). Applicant traverses this ground of rejection.

The cited prior art fails to disclose or suggest the "rigid inner member" as recited in each claim at issue. As defined in Webster's Ninth New Collegiate Dictionary, an excerpt of which is attached hereto as an appendix, the term "rigid" is defined as "deficient in or devoid of flexibility." Using this definition, the references relied on by the Office fail to disclose or suggest a rigid inner member that is also coupled to an inner shaft.

More specifically, the inner tube of Fischell includes a flexible portion, and therefore is not responsive to the rigid inner member. As noted above, the term rigid is defined as "deficient in or devoid of flexibility." Fischell clearly states that the inner tube 11 includes a distal portion 11A that is "highly flexible" (Fischell, column 4, line 12). Moreover, the flexible, distal portion 11A is not merely localized at a tip of the inner tube 11 but instead "extends for a considerable distance beyond the distal end of the balloon 16" (Fischell, column 4, lines 7-9). Still further, it is clear that the inner tube 11 must include the flexible portion 11A because it is inserted into the vasculature of the patient, which may follow a tortuous path. Consequently, because the inner tube 11 includes a highly flexible distal portion 11A, it is not "deficient in or devoid of flexibility," and therefore Fischell does not disclose or suggest a rigid inner member coupled to an inner shaft.

Burton similarly fails to disclose or suggest the rigid inner member specified in the claims at issue. Burton discloses a hollow core 5 that carries a grip member 9 for holding a stent 10. At least a distal portion of the hollow core 5 is inserted into the body cavity, which may follow a tortuous path, and therefore at least a portion of the hollow core 5 must be flexible. Thus, the hollow core 5 is not “deficient in or devoid of flexibility” and Burton does not disclose or suggest a rigid inner member coupled to an inner shaft.

Because Fischell and Burton, both individually and in combination, fail to disclose or suggest the claimed rigid inner member, it follows that the claims are not obvious over the cited prior art. Consequently, the prior art rejection asserted against the claims must be withdrawn.

Additionally, the cited prior art fails to teach or suggest the relationship between the inner and outer shafts as recited in the pending independent claims. Each independent claim requires the inner shaft to have distal end that is disposed proximally to the distal end of the outer shaft. Each claim further recites that the outer shaft has a first position, in which the distal end of the inner shaft is relatively farther from the distal end of the outer shaft, and a second position, in which the distal end of the inner shaft is relatively nearer to the distal end of the outer shaft. In both positions, however, the inner shaft distal end is disposed proximally to the distal end of the outer shaft.

The cited prior art does not teach this positional relationship between the inner and outer shafts. The inner tube 13 of Fischell has a distal end that is *always* disposed distally with respect to the distal end of the tube 24. See Fig. 1 of Fischell. Furthermore, Burton does not disclose both an inner and outer tube, and therefore fails to disclose the above-noted relationship therebetween. Thus, for at least this additional reason, the obviousness rejection based on the proposed combination of Fischell and Burton must be withdrawn.

Appl No 10/670,405  
Resp dated Nov 14, 2006  
Reply to Office action of Jul. 6, 2006

**CONCLUSION**

It is submitted that the present application is in good and proper form for allowance.  
A favorable action on the part of the Examiner is respectfully solicited

If, in the opinion of the Examiner a telephone conference would expedite prosecution  
of the subject application, the Examiner is invited to call the undersigned attorney

The Patent Office is hereby authorized to charge any deficiency in the fees filed,  
asserted to be filed or which should have been filed herewith (or with any paper hereafter  
filed in this application by this firm) to our Deposit Account No. 50-3629.

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Respectfully submitted,

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: the area over which a right-of-way exists b: the strip of land over which is built a public road c: the land occupied by a railroad, esp. for its main line d: the land used by a public utility (as for a transmission line) 3 a: a precedence in passing accorded to one vehicle over another by custom, decision, or statute b: the right of traffic to take precedence c: the right to take precedence over others (gave the bill the ~ in the Senate)

**right on** *adj* (1970) 1: exactly correct — often used interjectionally to express agreement 2 *usu* **right-on**: attuned to the spirit of the times

**Right Reverend** (15c) — used as a title for high ecclesiastical officials **right shoulder arms** *n* (ca. 1902): a position in the manual of arms in which the butt of the rifle is held in the right hand with the barrel resting on the right shoulder; also: a command to assume this position

**right-to-life** *adj* (1972): opposed to abortion — **right-to-lifer** *n* **right-to-work** *adj* (1949): opposing or banning the closed shop and the union shop

**right triangle** *n* (ca. 1924): a triangle having a right angle

**rightward** *adj* (1825): being toward or on the right

**right whale** *n* (1725): any of a family (Balaenidae) of whalebone whales having very long baleen, a large head on a stocky body, a smooth throat, and short, broad, rounded flippers



right whale

**right wing** *n* (1905) 1: the rightist division of a group or party 2

**right-wing** *adj* (1918) 1: *usu* **right-wing**: of or pertaining to the rightist division of a group or party 2

**rig-id** *adj* (MF or L; MF *rigidus*, fr. *L. rigidus*, fr. *rigere* to be stiff) 1 a: deficient in or devoid of flexibility (~ price controls) (a ~ bar of metal) b: appearing stiff and unyielding (his face ~ with pain) 2 a: inflexibly set in opinion b: strictly observed (adheres ~ to a ~ schedule) 3: firmly inflexible rather than lax or indulgent (~ disciplinarian) 4: precise and accurate in procedure (~ control of the manufacturing process) 5 a: having the gas containers enclosed within compartments of a fixed fabric-covered framework (a ~ ship) b: having the outer shape maintained by a fixed framework

**rig-id-ly** *adv* — **rig-id-ness** *n*

**rigid** implies uncompromising inflexibility; **rigorous** implies the imposition of hardship and difficulty; **strict** emphasizes unyielding conformity to rules, standards, or requirements; **stringent** suggests restrictions or limitations that curb or coerce. *syn* see in addition

**rigid-ly** *adv* — **rigid-ness** *n*

**rigid-ly** *adv* — **rigid-ness** *n*

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